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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,928	09/01/2000	David J. Pawson	50277-1534	7250

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HICKMAN PALERMO TRUONG & BECKER, LLP  
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SAN JOSE, CA 95125

EXAMINER
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GARCIA OTERO, EDUARDO

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/653,928

**Applicant(s)**

PAWSON, DAVID J.

**Examiner**

Eduardo Garcia-Otero

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2000.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-47 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/1/2000.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION: Non-Final (first action on the merits)**

***Introduction***

1. Title is: DYNAMIC PERSONALIZED CONTENT RESOLUTION FOR A MEDIA SERVER.
2. First named inventor is: PAWSON.
3. Claims 1-47 have been submitted, examined, and rejected.
4. US nonprovisional application filed 9/1/2000, and no earlier priority is claimed.

***Index of Important Prior Art***

5. **Bar-El** refers to WO 99/26415, published 27 May 1999.
6. **Computer Security** refers to Computer Security (Understanding Computers Series), Time-Life, 1986, ISBN 0-8094-5670-2, pages 23, and 74-75.
7. **Bowker** refers to US Patent 6,317,790.
8. **Rosin** refers to US Patent 6,260,192.
9. **Ellis** refers to US Patent 6,774,926.
10. **Zigmond** refers to US Patent 6,698,020.

***35 USC § 112-Second Paragraph-indefinite claims***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112: The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
12. **Claims 5, 11, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite** for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
13. In claim 5, the term “**removing one or more segments of digital video from said specified content based upon said user profile**” is not clear.
14. Also in claim 11, the term “**deleting a second set of audio or visual information resident within said specified content based upon said user profile**” is not clear.
15. In claim 13, the term “**said second set of audio or visual information corresponds to a subset of audio and visual information resident in said specified content that said user indicates in said user profile should not be used in constructing said customized digital data stream**” is not clear.

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16. In said claims 5, 11, and 13, said “removing” and “deleting” and “should not be used” are presently interpreted as referring to what occurs when advertisements are superimposed upon the requested video, as discussed at Bar-El specification page 1.
17. However, there is at least one other potential interpretation. It is possible that Applicant intends some type of security or access control. Said security or access control might limit a user to those services for which he has paid. Note that Bar-El discloses “charge money for their services” at page 10. Alternately, said security or access control might be used for parental control of a child’s viewing selections (blocking pornography). Note that Bar-El discloses “age” at page 7, and “child” at page 8. See MPEP 2173.01(i) regarding negative limitations.
18. Thus, claims 5, 11, and 13 are presently interpreted as referring to what occurs when advertisements are superimposed upon the requested video, as discussed at Bar-El specification page 1.

***Claim Rejections - 35 USC § 102(b)***

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action: A person shall be entitled to a patent unless – (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
20. **Claim 1-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Bar-El.**
21. Claim 1 is an independent claim with 4 limitations:
22. [1]-“**receiving a request for specified content by said user**” is disclosed by Bar-El at FIG 2 “REQUEST 1”.
23. [2]-“**consulting a user profile associated with said user**” is disclosed by Bar-El at FIG 2 “USER 1 PROFILE”.
24. [3]-“**determining the composition of said digital data stream based upon said user profile and said specified content**” is disclosed by Bar-El at FIG 2 “OBJECT STORAGE” and “VIDEO PERSONALIZATION MODULE 1”.
25. [4]-“**constructing said customized digital data stream**” is disclosed by Bar-El at FIG 2 “OBJECT STORAGE” and “VIDEO PERSONALIZATION MODULE 1”.

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26. In claim 2, **“delivering said customized digital data stream to said user”** is disclosed by Bar-El at FIG 2 “PER. VIDEO”.
27. In claim 3, **“delivering... over a network in real time”** is disclosed by Bar-El at page 1 “communication networks such as the telephone system or the Internet” and page 11 “real-time”.
28. In claim 4, **“storing said customized digital data stream in a fixed storage medium”** is disclosed by Bar-El at FIG 2 “VIDEO PERSONALIZATION MODULE 1” and page 11 “stored”.
29. Also in claim 4, **“allowing said user access said fixed storage medium”** is disclosed by Bar-El at FIG 2 “PER. VIDEO” and page 11 “stored”.
30. In claim 5, **“removing one or more segments of digital video from said specified content based upon said user profile”** is disclosed by Bar-El at FIG 2 element 34 and page 12 “implanted”. Note that said implanting effectively removes (deletes or overwrites) a segment of the requested video, as shown at FIG 2. And is also disclosed by Bar-El at page 1 “There are two forms of TV advertising. In one, an advertising video clip is shown between portions of a TV show or static images are superimposed on a portion of a screen. In another, bulletin boards of advertisements are seen”.
31. In claim 6, **“said segment of digital video corresponds to a portion of said specified content occurring between two intervals in time”** is disclosed by Bar-El at page 1 “There are two forms of TV advertising. In one, an advertising video clip is shown between portions of a TV show or static images are superimposed on a portion of a screen. In another, bulletin boards of advertisements are seen”. And also disclosed by Bar-el page 2 “The insertion of the images is typically performed at the local broadcasting station, and typically, the images to be inserted are advertisements for local products”.
32. In claim 7, **“said segment of digital video corresponds to a subset of audio or visual information found in said specified content”** is disclosed by Bar-El at page 1 “There are two forms of TV advertising. In one, an advertising video clip is shown between portions of a TV show or static images are superimposed on a portion of a screen. In another, bulletin boards of advertisements are seen”. And also disclosed by Bar-el page 2 “The insertion of

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the images is typically performed at the local broadcasting station, and typically, the images to be inserted are advertisements for local products”.

33. In claim 8, **“inserting one or more segments of digital video external from said specified content based upon said user profile”** is disclosed by Bar-El at FIG 2 “OBJECT STORAGE” and “VIDEO PERSONALIZATION MODULE 1”.
34. In claim 9, **“said segment of digital video external from said specified content contains both audio and visual information”** is disclosed by Bar-El at page1 “There are two forms of TV advertising. In one, an advertising video clip is shown between portions of a TV show or static images are superimposed on a portion of a screen. In another, bulletin boards of advertisements are seen”. And also disclosed by Bar-el page 2 “The insertion of the images is typically performed at the local broadcasting station, and typically, the images to be inserted are advertisements for local products”.
35. In claim 10, **“said one or more segments of digital video are presented to said user concurrently with said specified content”** is disclosed by Bar-El at page1 “There are two forms of TV advertising. In one, an advertising video clip is shown between portions of a TV show or static images are superimposed on a portion of a screen. In another, bulletin boards of advertisements are seen”. And also disclosed by Bar-el page 2 “The insertion of the images is typically performed at the local broadcasting station, and typically, the images to be inserted are advertisements for local products”. And also page 3 “animation within the banner is also common”.
36. In claim 11, **“inserting a first set of audio or visual information external from said specified content based upon said user profile”** is disclosed by Bar-El at page1 “There are two forms of TV advertising. In one, an advertising video clip is shown between portions of a TV show or static images are superimposed on a portion of a screen. In another, bulletin boards of advertisements are seen”. And also disclosed by Bar-el page 2 “The insertion of the images is typically performed at the local broadcasting station, and typically, the images to be inserted are advertisements for local products”. And also disclosed by Bar-El at FIG 2 element 34 and page 12 “implanted”. Note that said implanting effectively removes (deletes or overwrites) a segment of the requested video, as shown at FIG 2. And is also disclosed by Bar-El at page1 “There are two forms of TV advertising. In one, an advertising video clip is

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shown between portions of a TV show or static images are superimposed on a portion of a screen. In another, bulletin boards of advertisements are seen”.

37. Also in claim 11, **“deleting a second set of audio or visual information resident within said specified content based upon said user profile”** is disclosed by Bar-El at page1 “There are two forms of TV advertising. In one, an advertising video clip is shown between portions of a TV show or static images are superimposed on a portion of a screen. In another, bulletin boards of advertisements are seen”. And also disclosed by Bar-el page 2 “The insertion of the images is typically performed at the local broadcasting station, and typically, the images to be inserted are advertisements for local products”. And also page 3 “animation within the banner is also common”.
38. In claim 12, **“said first set of audio or visual information includes frames of digital video”** is disclosed by Bar-El at page1 “There are two forms of TV advertising. In one, an advertising video clip is shown between portions of a TV show or static images are superimposed on a portion of a screen. In another, bulletin boards of advertisements are seen”. And also disclosed by Bar-el page 2 “The insertion of the images is typically performed at the local broadcasting station, and typically, the images to be inserted are advertisements for local products”. And also disclosed by Bar-El at FIG 2 element 34 and page 12 “implanted”. Note that said implanting effectively removes (deletes or overwrites) a segment of the requested video, as shown at FIG 2. And is also disclosed by Bar-El at page1 “There are two forms of TV advertising. In one, an advertising video clip is shown between portions of a TV show or static images are superimposed on a portion of a screen. In another, bulletin boards of advertisements are seen”.
39. In claim 13, **“said second set of audio or visual information corresponds to a subset of audio and visual information resident in said specified content that said user indicates in said user profile should not be used in constructing said customized digital data stream”** is disclosed by Bar-el page 2 “The insertion of the images is typically performed at the local broadcasting station, and typically, the images to be inserted are advertisements for local products”. Note that inserting advertisements for local products implies excluding advertisements designed for other localities. For example, if user profile indicates locality A, then local advertisements for locality B would be excluded.



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40. Claims 14-20 are "sending customized data stream" type claims, and are rejected for the same reasons as the "constructing a digital data stream" type claims 1-13 above.
41. Claims 21-40 are "computer readable medium" type claims, and are rejected for the same reasons as the "constructing a digital data stream" type claims 1-13 above.
42. Claims 41-47 are "system" type claims, and are rejected for the same reasons as the "constructing a digital data stream" type claims 1-13 above.

***Additional Cited Prior Art***

43. The following US patents or publications are hereby cited as prior art, but have not been used for rejection. Applicant should review these carefully before responding to this office action.
44. Computer Security discloses "passwords" at page 23, and "multi-user system" with "varying degrees of access" at pages 74-75.
45. Bowker discloses "User becomes Identified" and "is user authorized?" at FIG 1.
46. Rosin discloses "internet on-demand system for television" and "intelligent agent" at Abstract.
47. Ellis discloses "personal television program schedule information...set favorites, to establish parental controls" at Abstract.
48. Zigmond discloses "selecting and inserting advertisements...according to advertisement selection criteria combined with viewer and system information" at Abstract.

***Conclusion***

49. All claims stand rejected under 35 USC 102(b).
50. Also, claims 5, 11, and 13 stand rejected under 35 USC 112 as indefinite.

***Communication***

51. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo Garcia-Otero whose telephone number is 703-305-0857. The examiner can normally be reached on Tuesday through Friday from 9:00 AM to 8:00 PM. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kevin Teska, can be reached at (703) 305-9704. The fax phone number for this group is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist, at (703) 305-3900.

\* \* \* \*

JEAN R. MOORE  
PRIMARY EXAMINER

